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In re Application of :
BATEMAN et al. :
Application No.: 10/533,579 : DECISION ON PETITION
PCT No.: PCT/AU2003/001443 :
Int. Filing Date: 31 October 2003 : UNDER
Priority Date: 31 October 2002 :
Attorney Docket No.: B-5691PCT 622624-8 : 37 CFR 1.497(d)
For: FIRE RESISTANT MATERIAL :

This decision is in response to applicants' "REQUEST TO DELETE INVENTORS" filed in the United States Patent and Trademark Office (USPTO) on 07 March 2006 and the supplemental submission filed 31 March 2006, which have properly been treated as a petition under 37 CFR 1.497(d).

BACKGROUND

On 31 October 2003, applicants filed international application PCT/AU2003/001443, which designated the United States and claimed a priority date of 31 October 2002. A copy of the international application was communicated to the USPTO from the International Bureau on 13 May 2004. The thirty-month period for paying the basic national fee in the United States expired at midnight on 02 May 2005 (30 April 2005 being a Saturday).

On 02 May 2005, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, the basic national fee and an unsigned declaration of inventors.

On 07 December 2005, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(h) for filing any of the search fee, the examination fee, or the oath or declaration after the date of the commencement of the national stage were required.

On 07 March 2006, applicants filed a "REQUEST TO DELETE INVENTORS", which has properly been treated as a petition under 37 CFR 1.497(d), and the surcharge under 37 CFR

1.492(h). The petition was accompanied by a declaration of Matthew Allen Anglin, a declaration of James Macon Peterson, and a declaration of inventors identifying Stuart Arthur Bateman, Matthew Jon Partlett, and Dong Wang Yu as the inventors and signed by them.

On 31 March 2006, applicants filed a supplemental submission which included a declaration of Barbara Lord MacLean.

On 27 July 2006, the DO/EO/US mailed a NOTIFICATION OF DEFECTIVE RESPONSE (Form PCT/DO/EO/916) indicating that the declaration of inventors filed 07 March 2006 did not identify all of the inventors.

DISCUSSION

The NOTIFICATION OF DEFECTIVE RESPONSE mailed 27 July 2006 was mailed in error (i.e., applicant's petition under 37 CFR 1.497(d) had not been taken into account) and is hereby VACATED.

37 CFR 1.497(d), provides:

(d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, or if a change to the inventive entity has been effected under PCT Rule 92^{bis} subsequent to the execution of any oath or declaration which was filed in the application under PCT Rule 4.17(iv) or this section and the inventive entity thus changed is different from the inventive entity identified in any such oath or declaration, applicant must submit:

- (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
- (2) The processing fee set forth in Sec. 1.17(i); and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see Sec. 3.73(b) of this chapter); and
- (4) Any new oath or declaration required by paragraph (f) of this section.

Applicants have not satisfied item (1). The statements by the three deleted inventors each fail to state that the error in inventorship in the international application occurred without deceptive intention but not that the error occurred without deceptive intention *on his or her part*.

As to item (2), the processing fee of \$130 has been charged to Deposit Account No. 12-0415.

Item (3) has not been satisfied. No mention is made in the petition regarding whether an assignment has been executed. If an assignment has been executed, the written consent of the assignee is required. See MPEP § 324 for a proper showing under 37 CFR 3.73(b).

As to item (4), a new declaration is not required by 37 CFR 1.497(f) in the instant situation.

CONCLUSION

The request under 37 CFR 1.497(d) is **DISMISSED** without prejudice for the reasons set forth above.

The NOTIFICATION OF DEFECTIVE RESPONSE mailed 27 July 2006 is **VACATED** for the reasons set forth above.

If reconsideration on the merits of this petition is desired, a proper reply must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.497(d)." No additional petition fee is required.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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